



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/702,825 | 11/01/2000 | Cary Lucier | P66053US0 | 1075 |

7590

01/13/2004

Jacobson Price Holman & Stern
Professional Limited Liability Company
The Jenifer Building
400 Seventh Street N W
Washington, DC 20004-2201

| |
|----------|
| EXAMINER |
|----------|

ACKUN, JACOB K

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3712

DATE MAILED: 01/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/702,825

Applicant(s)

LUCIER, CARY

Examiner

Jacob K. Ackun Jr.

Art Unit

3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Art Unit: 3712

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The negative limitation "non-interengageable", now added to claim 1, was not described in the disclosure as originally filed and therefore constitutes New Matter.

3. The amendment filed 10/22/03 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Note the comments above.

Applicant is required to cancel the new matter in the reply to this Office Action.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are indefinite because the limitation "non-interengageable", as recited in claim 1, appears to be inaccurate. The protrusions of the structures disclosed would appear to be inherently interengageable by, for example, placing one card against another. Also note, for

Art Unit: 3712

example, the structures at the right side of Fig 5 that appear to show protrusions on different elements in engagement with each other.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for.

7. Claims 1-11, 14-15 and 18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Fabre (cited by the applicant). Fabre discloses a set of elements (such as element 10 in Fig. 1) having all of the structural elements of the claims, such as those recited on lines 3-6 of claim 1, for example. Since the devices of Fabre have all of the claimed structure, they are presumed to be inherently capable of all of the claimed functions, such as those recited in lines 7-14 of claim 1, for example.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 12, 13, 16, 17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fabre. Fabre discloses most of the elements of the claims (as indicated above with respect to claims from which claims 12, 13, 16, 17 and 20 depend), but does not teach the specific limitations of these claims. On the other hand, it would have been obvious to construct the devices of Fabre as claimed, for the purpose of facilitating easier use thereof.

10. Claims 1-12 and 14-15 are rejected under 35 U.S.C. 102(b) or (e) as being anticipated by Wolfe (5,788,233). Wolfe discloses building blocks which appear to be "non-interengageable" in the sense applicant is presumed to interpret the limitation. The blocks of Wolfe are also considered to be inherently capable of use as recited in the claims (note claim 1 last two paragraphs, for example), since they possess all of the claimed structural elements. The blocks are for building structures that are considered to be easily assembled and disassembled. The blocks shown in figs 3 and 5 comprise a set of flat structures, as required in the claims.

11. Claims 13 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolfe. Wolfe discloses most of the elements of the claims, but may not disclose designs comprising words or images on the toy elements or the specific shapes of the protrusions recited in the claims. On the other hand the missing elements are conventional in the relevant art (note for example some of the prior art of record). It would have been obvious to one having ordinary skill in the art to provide the device of Wolfe with the noted missing elements for the purpose of rendering the elements more attractive and easier to construct and use.

12. Applicant's arguments filed 10/22/03 have been fully considered but they are not persuasive. As noted above the limitation "non interengageable" is a negative limitation not affirmatively described in the specification as filed, but introduced into the disclosure to

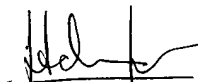
Art Unit: 3712

overcome an applied prior art reference. Since no support can be found in the specification regarding precisely what is considered to be interengageable and non-interengageable, the above rejections are now made. Additionally, the applicant's comments regarding the intended use limitations in the claims are not convincing. Flat structures having protrusions, as structurally encompassed in claim 1, are considered to be inherently capable of all of the functions recited in that claim (since they have all of the structure in the claim). It is believed to be well settled that a claim to a product does not avoid prior art showing all of the claimed structure merely because the claim recites a different function than disclosed by the prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob K. Ackun Jr. whose telephone number is (703)308-3867. The examiner can normally be reached on Monday through Friday 8.30AM-5.00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703)308-1745. The fax phone number for the organization where this application or proceeding is assigned is (703)305-3579.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0858.



Jacob K. Ackun Jr.
Primary Examiner
Art Unit 3712

J.A.